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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/710,308	07/01/2004	David S. Bonalle	70655.1400	4307
20322	7590	11/29/2005	EXAMINER	
SNELL & WILMER ONE ARIZONA CENTER 400 EAST VAN BUREN PHOENIX, AZ 850040001			WALSH, DANIEL I	
		ART UNIT		PAPER NUMBER
				2876

DATE MAILED: 11/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/710,308	BONALLE ET AL
	<b>Examiner</b>	<b>Art Unit</b>
	Daniel I. Walsh	2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 14 September 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-12 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-10 and 12 is/are rejected.
- 7) Claim(s) 11 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date: _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

1. Receipt is acknowledged of the Amendment received on 14 September 2005.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claim 1-10 and 12 rejected under 35 U.S.C. 103(a) as being unpatentable over Li (US 2002/0153424) in view of Saito (US 2005/0240778).

Re claim 1, Li teaches a smartcard that has a biometric (fingerprint) sensor thereon for receiving a proffered biometric (fingerprint), and that the biometric is associated with at least two of charge card accounts and facilitating authorization of a smartcard transaction using at least one of the two accounts (FIG. 1, FIG. 2, FIG. 3, claim 11, paragraph [0011]) , as Li teaches

a smart card (card with a processor/controller) that receives a biometric sample for authentication of a user, and that and that the selected card is used for a transaction.

Li teaches that the fingerprint is registered/stored on the card, but it silent to the fingerprint being verified.

Saito teaches that a fingerprint is verified as real (paragraph [0057]).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Li with those of Saito.

One would have been motivated to do this in order to ensure that a sample is real/live, for security purposes.

Re claim 2, the Examiner notes that as the card has a reference print thereon for authentication/verification, it would have been obvious to initialize the card, by storing a reference print thereon. Accordingly, it would have been obvious to register the sample with the card, for a reference sample, where the card is interpreted as an authorized sample receiver.

Re claim 3, verification has been discussed above. Additionally, the Examiner notes that by interpreting the card as a sample receiver, the sample is proffered, the receiver is contacted, and the sample is stored, verified, and associated.

Re claim 4, microcontroller 10 compares the sample. A sample obviously would be stored if it's the reference sample. Additionally, the Examiner notes that verification has been discussed above. Finally, it is obvious that comparisons are performed for matching of samples for subsequent transactions.

Re claim 5, though silent to a database, it would have been an obvious expedient to use a database on the card to store the various data of the user. One would have been motivated to do

this in order to organize the data, as is conventional in the art. The Examiner notes that it would therefore have been obvious to process the information for transactions and authorization.

Re claim 6, paragraph Li teaches the fingerprint can be stored in the card (paragraph [0020]).

Re claim 7, the microcontroller 10 compares the samples to a stored sample, and is interpreted as a local CPU.

Re claim 8, though silent to detecting/processing/storing a second biometric sample, the Examiner notes that it is well known and conventional that additional security can be obtained with additional samples (as discussed in the previous Office Actions by the Applicant). One would have been motivated to have more samples in order to have increased security.

Re claim 9, it has been discussed above that a live finger is detected. This is interpreted as a secondary security procedure. Though silent to sending a signal to show that a rule is being violated (finger is not live) the Examiner notes it would have been obvious to send the signal/display such information as a means to convey to the user that the sample is invalid.

Re claim 10, a fingerprint has been discussed above, re claim 1.

Re claim 12, Li teaches AMEX/MC/Discover, which are unrelated accounts.

3. Claims 1-10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burchette, JR (US 2003/0106935), in view of Saito, as discussed above.

Re claim 1, Burchette, JR. teaches receiving a proffered biometric sample at a biometric sensor on a smartcard to form a proffered biometric sample, wherein the biometric sample is associated with at least two credit card accounts and facilitating authorization for a smartcard transaction using one of said accounts (paragraph [0043] and FIG. 9A).

Burchette, JR. is silent to verifying the sample.

Saito teaches verifying the sample (see above).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Burchette, JR. with those of Saito.

One would have been motivated to do this for additional security.

Re claim 2, Burchette, JR. teaches registering the sample with an authorized sample receiver, by storing the sample on the host (10).

Re claim 3, Burchette, JR teaches associating the sample with user information, as it is linked to different accounts (paragraph [0042]). Additionally, it has been discussed above that the sample is proffered to the receiver (card), the sample is verified (live sample), and it's stored as a reference sample for subsequent authorization of transactions.

Re claim 4, the received sample is compared for authentication/verification.

Additionally, the sample is stored (reference sample), and verified as discussed above.

Re claim 5, though silent to a database, it would have been an obvious expedient to use a database on the card to store the various data of the users and their various accounts. One would have been motivated to do this in order to organize the data, as is conventional in the art. The Examiner notes that it would therefore have been obvious to process the information for transactions and authorization.

Re claim 6, when the fingerprint sample is received, it is compared against a stored sample (reference) for verification/authentication.

Re claim 7, as the comparison is performed locally, it would have been obvious to one of ordinary skill in the art that a local CPU/microprocessor would perform the comparison, as an efficient and reliable means to automatically perform a comparison.

Re claim 8, it is well known that additional fingerprints/biometrics would provide additional security. Though silent to a second sample, the Examiner notes it would have been obvious to one of ordinary skill in the art to receive a second sample, for increased security.

Re claim 9, it has been discussed above that a live finger is detected. This is interpreted as a secondary security procedure. Though silent to sending a signal to show that a rule is being violated (finger is not live) the Examiner notes it would have been obvious to send the signal/display such information as a means to convey to the user that the sample is invalid.

Re claim 10, Burchette, JR. teaches a fingerprint sensor (410)

Re claim 12, the Examiner notes that the different cards (AMEX/VISA) are unassociated accounts.

#### *Additional Remarks*

4. Pitroda (US 6,925,439) teaches consolidated cards with PIN access. It would have been obvious to replace the PIN with biometrics for security.

#### *Allowable Subject Matter*

5. Claim 11 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. The following is a statement of reasons for the indication of allowable subject matter:  
The prior art of record is silent to the step of initiating verification of the proffered biometric samples includes verifying whether the biometric sample is associated with a present transaction limit on at least one of the card accounts (debit/credit/charge), savings account, private label account, and loyalty point account. Though the Examiner notes that credit cards as known to have preset transaction limits, the Examiner notes that a step of verifying a biometric sample including *verifying* (emphasis added) whether the sample is associated with a preset transaction limit is non-obvious to the Examiner.

***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).  
Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel I. Walsh whose telephone number is (571) 272-2409. The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel I Walsh  
Examiner  
Art Unit 2876  
11-25-05



KARL D. FRECH  
PRIMARY EXAMINER